

Remarks

Applicants appreciate the recognition of patentable subject matter in the present application.

Applicants hereby add new claims 21-23. Accordingly, claims 1-23 are pending in the present application.

Claims 1, 5-8, 12-14, and 18-20 stand rejected under 35 USC 103(a) for obviousness over U.S. Patent No 4,167,322 to Yano et al. in view of U.S. Patent No 6,023,593 to Tomidokoro. Claims 2-4, 9-11, and 15-17 are allowed.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring to the prior art rejections, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8<sup>th</sup> ed.). As discussed below, there is no motivation to combine the reference teachings, and even if combined, the combination fails to disclose or suggest positively-recited limitations of the claims. The 103 rejections are improper for at least these reasons as further discussed below.

Referring to the rejection of claim 1, the Examiner relies upon the teachings of Yano which includes a plurality of coupled copiers to allegedly teach the claimed interface and processing circuitry. As set forth in col. 4 of Yano, one of the copiers may display status parameters of another of the copiers. A user of Yano may use control panel 42 of one copier to select another copier and the parameter whose status is desired to be depicted. Yano is merely directed towards *display of parameters of different copiers with absolutely no teaching or suggestion of one of the copiers (or other structure) configuring another of the copiers*.

Tomidokoro is directed towards a system which provides data communication apparatus 200 configured to poll individual copiers 100 and receives data regarding consumables responsive to the polling. Tomidokoro is void of any teaching or suggestion of data communication apparatus 200, central controlling

device 400, or other structure of configuring one of the copiers. In no fair interpretation may polling be fairly considered to disclose or suggest configuration of the copier 100.

Accordingly, the individual copiers of Yano merely provide status information of another copier and there is no teaching or suggestion of one of the copiers configuring another of the copiers. The polling system of Tomidokoro provides the polling by apparatus 200 to gather consumable data from copiers 100 and fails to disclose or suggest any configuration of one of the copiers 100 using apparatus 200 or other structure. Turning to limitations of claim 1, taken alone or in combination, Yano or Tomidokoro are void of any teaching or suggestion of the claimed *processing circuitry configured to communicate with the image forming device (initially configured to cause the formation of an initial consumable order assist function) to configure the image forming device to cause the formation of another one of the consumable order assist functions.*

The prior art teachings also fail to disclose to suggest the *configuration of the image forming device to cause the formation of the another function responsive to the status of the imaging consumable within the image forming device* as claimed. The Action on page 3 states that Yano fails to teach the above-identified limitations since Yano is not concerned with communicating orders for replenishment. Further, the sensor of Yano merely monitors the consumable level for providing status information of the consumable life. Yano at col. 4, lines 67-69 state that depression of suitable keys causes data signals to be fed as opposed to outputting as a result of output from a sensor. Tomidokoro discloses communication of data from a copier 100 to apparatus 200 responsive to a polling signal and does not teach or suggest configuration to cause formulation of the another function responsive to a status of the imaging consumable as claimed. This additional limitation is not taught nor suggested by the prior art and claim 1 is allowable for this additional reason.

In addition, the combination of the teachings of Tomidokoro with the teachings of Yano is improper and the 103 rejection of claim 1 is improper for at least this additional reason. As mentioned on page 3 of the Office Action, Yano is not concerned with communicating orders for toner. Thereafter on page 4, it is baldly alleged that the combination is appropriate to enable a copying machine to

create and transmit a consumable request. The Action merely states that the combination can be made and is therefore appropriate. However, the mere fact that references *can* be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*. MPEP §2143.01 *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). There is no sufficient motivation presented in the Action and the rejection is improper for at least this reason.

As mentioned above, Yano is void of any teachings directed towards an image forming device being configured by another device or apparatus. The allegation on page 4 of the Action that the combination is appropriate to modify Yano by providing a means for enabling a copying machine to create and transmit a consumable order request using Tomidokoro teachings directed towards a polling arrangement for placing an order is unrelated to or otherwise not sufficient to motivate one to modify the arrangement of Yano to accommodate the claimed configuration of image forming devices using the apparatus of claim 1. In other words, any motivation to modify a device to place an order does not motivate one to configure an image forming device initially configured to formulate an initial function to formulate another function.

The alleged motivation is not relevant to the curing the deficiencies of Yano with respect to the claimed processing circuitry of the apparatus of claim 1 communicating with the image forming device to **configure** the image forming device. The alleged motivate is deficient as set forth by the Federal Circuit. More specifically, the Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The Court in *In re Lee* stated the factual inquiry whether to combine references must be **through and searching**. It must be based **on objective evidence of record**. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some **objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art** would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's **conclusory statements** in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and **can not be resolved on subjective belief and unknown authority**. **The Court also stated**

**that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.**

In the instant case, **the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation** as set forth by the Federal Circuit. The Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth objective rationale on which it relied.

Further with respect to the deficiency of the 103 combination of references, Yano is related to monitoring by one copier of other copiers. Yano provides that a user can monitor status of the copiers at col. 6, lines 14-20. Tomidokoro is directed to an extensive system external of the copier group 100 which orders consumables as opposed to the copiers themselves of group 100. Any combination of teachings of Tomidokoro regarding the external system with the copiers of Yano would require significant modification which would change the principle of operation of the system of Yano including the copier group. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP §2143.01 (8<sup>th</sup> Edition) *citing In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (reversing a rejection wherein the suggested combination of references would require a change in the basic principle under which the construction was designed to operate.) 270 F.2d at 813, 123 USPQ at 352. The combination of reference teachings is inappropriate for at least these reasons and claim 1 is allowable.

In view of the above, the combination of the teachings of Tomidokoro with the teachings of Yano is improper. As identified above, even if the references are combined, positively recited limitations of claim 1 are not shown nor suggested by the prior art and claim 1 is allowable for this additional reason.

The Office Action fails to identify prior art teachings which allegedly disclose limitations of claim 1 (e.g., the claimed processing circuitry configuring the image forming device or the configuration to cause the formation of the another function responsive to the status of the imaging consumable) or identifies sections of the

prior art which allegedly disclose various teachings which do not correspond to any limitations of pending claim 1 (e.g., reference to replacement of a variable on page 3 of the Action). In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicants respectfully request clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if any claims are not found to be allowable.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, claim 5 recites the processing circuitry is configured to write a variable to the image forming device to configure the image forming device. Yano discloses displaying a status of a copier responsive to user input via a control panel of another copier. The mere display of status fails to disclose or suggest any configuration of a device by writing a variable. In addition, a keyboard fails to disclose or suggest the claimed processing circuitry configured to write the variable. Numerous limitations of claim 5 are not shown nor suggested and claim 5 is allowable.

Referring to claim 8, the Office Action states on page 5 that it would have been obvious to provide a computer program for performing the steps suggested in the combined teachings of Yano and Tomidokoro so processing steps may be performed by a computer. The combination of reference teachings is improper, and even if combined, the combination fails to teach or suggest positively-recited

limitations of claim 8.

There is no motivation to combine the reference teachings for at least the compelling reasons set forth above. In addition, the Office Action on page 5 fails to present any motivation to combine the reference teachings in support of the rejection of claim 5. The Office has failed to establish a prima facie 103 rejection for this reason and claim 8 is allowable.

In addition, the prior art, even if combined, fails to disclose or suggest the claimed *configuring the image forming device (which is initially configured to cause the formation of an initial function) to cause the formation of another consumable assist order function*. Yano is directed to one copier displaying status of another copier, and Tomidokoro is directed towards polling a copier and receiving data from the copier. Both references are devoid of the claimed configuring and claim 8 is allowable for at least this reason. Further, the references taken alone or in combination fail to disclose or suggest the claimed *formation of the another function responsive to the status of the imaging consumable*. Numerous positively recited limitations of claim 8 are not taught nor suggested by the prior art and claim 8 is in condition for allowance.

Pursuant to the CFR, if claim 8 is not allowed, Applicants respectfully request issuance of a non-final Action which properly identifies prior art teachings relied upon as allegedly disclosing the above-recited limitations so Applicants may appropriately respond during the prosecution of this application.

Referring to claim 14, there is no motivation to combine the reference teachings in support of the rejection of claim 14 and the Office has failed to establish a prima facie 103 rejection for at least this reason.

In addition, the references even if combined fail to disclose or suggest the claimed configuring the image forming device (which is initially configured to cause the formation of an initial function) to cause the formation of another function as positively claimed. The prior art is void of the disclosing or suggesting the claimed configuring of the image forming device to formulate the another function *responsive to the status of the imaging consumable* as also positively-claimed. Numerous limitations of claim 14 are not disclosed nor suggested by the prior art and claim 14 is allowable.

Referring to the statement on page 4 of the Action that the method claims

Serial No. 09/710,367  
PDNO. 10008371-1  
Amendment A

correspond to the apparatus claims, Applicants note that the Office has failed to identify any teachings which allegedly disclose the claimed configuring. If claim 14 is not allowed, Applicants respectfully request identification of prior art teachings which allegedly disclose the limitations of claim 14 including the configuration in accordance with the CFR so Applicants may appropriately respond during the prosecution of this application.

Applicants hereby add new claims 21-23 which are supported at least by Figs. 2-4 and the associated specification teachings of the originally-filed application.

Applicants respectfully request entry of the amendment to the specification indicated herein to correct the informality.

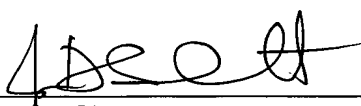
Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

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